APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,009	12/26/2001	Yuichi Takatsu	65316-0008	2437

10291   7590   05/02/2006

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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/036,009	TAKATSU, YUICHI
		Examiner	Art Unit
		DANIEL LASTRA	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 18-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 18-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-16 and 18-21 have been examined. Application 10/036,009 (ELECTRONIC SETTLEMENT APPARATUS ELECTRONIC SETTLEMENT METHOD, STORAGE MEDIUM AND COMPUTER DATA SIGNAL) has a filing date 12/26/2001 and foreign priority 12/28/2000.

Response to Amendment

2.   In response to Advisory Action filed 02/06/2006, the Applicant filed an RCE on 02/16/2006, which amended claims 1 and 18-21.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recites "*whereby said discount points stored in said memory are prevented from being permanently updated based on incomplete or interrupted transactions until after said settlement data is supplied to said processor*". For purpose of art rejection, the Examiner would interpret said limitation as storing points in a temporary point account before the settlement of said points (see Applicant's specification page 6, lines 8-20).

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Breck (US 2004/0210449).

As per claims 1 and 19-21, Breck teaches:

An electronic settlement apparatus comprising:

memory for storing discount points representing a property value to be associated with a user to which the said discount points are assigned (see paragraph 102); and

a processor, wherein said processor obtains goods data that designates goods and use point data that designates an amount to be appropriated for the price of the said goods, decides the discount points to be newly assigned to said user based on said obtained goods data,

generates temporary balance data representing a result obtained by varying the discount points stored in said memory by amount corresponding to a value obtained by subtracting the discount points designated by use point data from the discount points decided to be newly assigned to said user (see paragraphs 106-107),

and when settlement data, which represents that settlement of purchase of said

goods is completed, is supplied, said processor decides that goods represented by said

goods data is goods that said user will purchase and updates, in response to the

decision of goods that said user will purchase, said discount points stored in said

memory according to the result represented by said temporary balance data (see

paragraphs 101-107);

whereby said discount points stored in said memory are prevented from being

permanently updated based on incomplete or interrupted transactions until after said

settlement data is supplied to said processor (see paragraph 106). Breck teaches

storing points in a temporary point account (i.e. "MR-STN account") before the

settlement of said points, similar to Applicant's specification page 6, lines 8-20).

As per claim 2, Breck teaches:

The electronic settlement apparatus according to claim 1, further comprising a

receiving server for obtaining said goods data and said use point data from an external

section via a network so as to be transferred to said processor, wherein said processor

obtains said goods data and said user point data transferred from said receiving server

(see paragraph 103).

As per claim 3, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said memory

stores user identification data that identifies the user to which said discount points are

assigned to be associated with said discount points, and a password associated with

the said user identification data (see paragraph 105); and

said processor obtains information and password representing said user; determines whether or not said memory stores said user identification data that identifies the user represented by said obtained information and said obtained password to be associated with each other; and stops obtaining said goods data or said user point data when determining that said memory stores neither user identification data nor said password to be associated with each other (see paragraph 105).

As per claim 4, Breck teaches:

The electronic settlement apparatus according to claim 3, wherein said processor obtains information, which is supplied from an external section and which represents the user, in accordance with an instruction supplied from the external section, and generates said user identification data that identities the user represented by obtained information and said password associated with the said user identification data, and store said user identification data and password in said memory (see paragraph 105).

As per claim 5, Breck teaches:

The electronic settlement apparatus according to claim 3, wherein said memory stores user information unique to the user identified by said corresponding user identification data to be associated with said user identification data (see paragraph 105).

As per claim 6, Breck teaches:

The electronic settlement apparatus according to claim 5, wherein when said processor determines that said user identification data that identities the user represented by said information obtained by the processor and said password obtained

by the processor are stored in said memory to be associated with each other, said processor updates said user information stored in grid memory to be associated with the said user identification data to user information supplied from the external section (see paragraph 105).

As per claim 7, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein when said processor determines whether or not said settlement data is supplied to the processor until a predetermined time has elapsed after obtaining goods data, and when said processor determines that no settlement data is supplied thereto, said processor abandons the obtained corresponding goods data (see paragraph 105).

As per claim 8, Breck teaches:

The electronic settlement apparatus according to claim 1, further comprising a settlement server, wherein said settlement server stores settlement points representing a property value to be associated with identification data unique to the said settlement points (see paragraph 103);

determines whether or not said processor obtains said goods data and said use point data; obtains said identification data from the external section when it is determined that said processor obtains said goods data and said use point data, decides that a difference between an amount of settlement points corresponding to the price of goods represented by said goods data and an amount of settlement points corresponding to the discount points represented by said use point data is appropriated for the price of the said goods; and supplies said settlement data to said processor

when the settlement points associated with 5 said obtained identification data are more

than said difference (see paragraphs 103-107).

As per claim 9, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said memory

stores conversion rate data representing a conversion rate between said discount points

and said settlement points, and said processor specifies the amount of settlement

points corresponding to the discount points represented by said use point data

according to the conversion rate represented by said conversion rate data (see

paragraph 106).

As per claim 11, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said processor

determines whether or not the discount points represented by the use point data

obtained by the processor are more than predetermined available points, and handles

the said available points as discount points (see paragraph 106).

As per claim 12, Breck teaches:

The electronic settlement apparatus according to claim 2, wherein said receiving

server supplies goods data and use point data obtained by said receiving server to said

processor via a LAN (Local Area Network); and said processor decides discount points

to be newly assigned to said user based on the price of said goods data supplied from

said receiving server, and updates said discount points stored in said memory to be

varied by an amount corresponding to a value obtained by subtracting the discount

points designated by use point data supplied from said receiving server from the discount points (see paragraphs 103-107).

As per claim 13, Breck teaches:

The electronic settlement apparatus according to claim 2, wherein said receiving server supplies goods data and use point data obtained by said receiving server to said processor via a WWW (World Wide Web); and said processor decides discount points to be newly assigned to said user based on the price of said goods data supplied from said receiving server, and updates said discount points stored in said memory to be varied by an amount corresponding to a value obtained by subtracting the discount paints designated by use point data supplied from said receiving server from the discount points decided by said processor (see paragraphs 103-107).

As per claim 14, Breck teaches:

The electronic settlement apparatus according to claim 13, wherein said receiving server venerates order identification data unique to each goods data obtained by said receiving server so as to be supplied to said processor, and supplies reception identification data unique to said receiving server to said processor to be associated with said goods data (see paragraphs 103-107).

As per claim 15, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said memory stores assignment rate data that designates discount points to be newly assigned to said user per unit quantity of the price of said goods; and said processor decides a value obtained by multiplying the price of goods represented by goods data obtained by

the processor by the discount points designated by said assignment rate data as discount points to be newly assigned to said user (see paragraph 106).

As per claim 16, Breck teaches:

The electronic settlement apparatus according to claim 1, wherein said goods data includes point designation information that designates discount points to be assigned to a person who purchases goods represented by the said goods data; and said processor decides the discount points represented by said point designation information included in said goods data obtained by said processor as discount points to be newly assigned to said user (see paragraph 106).

As per claim 18, Breck teaches:

An electronic settlement apparatus comprising:

a receiving server for obtaining goods data that designates goods and use point data that designates an amount to be appropriated for the price of the said goods in the discount points representing a property value from an external section via a network (see paragraph 103);

memory for storing said discount points to be associated with a user to which the said discount points are assigned (see paragraph 102); and

a processor (see paragraph 103),

wherein said memory further stores user identification data that identifies the user to which the said discount points are assigned to be associated with said discount points (see paragraph 106), and

a password associated with the said user identification data; and said processor

obtains information sold password representing said user from an external section (see

paragraph (see paragraph 105);

determines whether or not said memory stores said user identification data, that

identifies the user represented by said obtained information and said obtained password

to be associated with each other (see paragraph 105);

obtains goods data and use point data obtained by said receiving server from

said receiving, server via said network when determining that said memory stores said

user identification data and said password to be associated with each other (see

paragraph 105);

prevents said receiving server from obtaining said goods data or said user point

data when determining that said memory stores neither user identification data nor said

password to be associated with each other; decides discount points to be newly

assigned to said user based on the said goods data obtained by said receiving server

(see paragraph 106);

generates temporary balance data representing a result obtained by varying the

discount points stored in said memory by amount corresponding to a value obtained by

subtracting the discount points designated by use point data from the discount points

decided to be newly assigned to said user (see paragraph 106-107),

decides that goods represented by goods data obtained from said receiving

server is handled as goods that said user will purchase when settlement data

representing that settlement of the purchase of said goods is completed is supplied from

the external section (see paragraphs 103-107); and updates, in response to the decision of goods that said user will purchase, said discount points stored by said memory according to the result represented by said temporary balance data (see paragraph 106).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Breck</u> et al (US 2004/0210449).

As per claim 10, <u>Breck</u> does not expressly teach:

The electronic settlement apparatus according to claim 1, wherein said processor determines whether or not the price of goods represented by said goods data reaches a predetermined minimum purchase amount, and decides that no discount point is assigned to said user when determining that the price of goods does not reach the predetermined minimum Purchase amount. However, Official notice is taken that deciding the minimum amount of purchase in order to achieve a reward is old and well known. For example, is it old and well known that online retailers provide free shipping to customers that purchase more than a certain limit amount, such as fifty dollars. It

would have been obvious to a person of ordinary skill in the art at the time of applicant's invention was made, to know that <u>Breck</u>'s participant merchants would only grant rewards to customers that purchase more than a minimum purchase amount because this would motivate customers to spend more money in the participating merchants.

Response to Arguments

6.   Applicant's arguments filed 02/16/2006 have been fully considered but they are not persuasive. The Applicant argues that <u>Breck</u> does not teach *"whereby said discount points stored in said memory are prevented from being permanently updated based on incomplete or interrupted transactions until after said settlement data is supplied to said processor"*. The Examiner answers that on paragraph 95, the last 2 sentences, <u>Breck</u> states "During the authorization process, the STN 15 is compared with the merchant-defined conditions where if the conditions are not satisfied, the authorization request will be denied. After completion of the transaction, and upon satisfying the merchant 2 conditions, the STN 15 have little to no value and would be of minimal value to a potential thief". This suggests that the points are not updated until the conditions are met or after completion of the transaction.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.
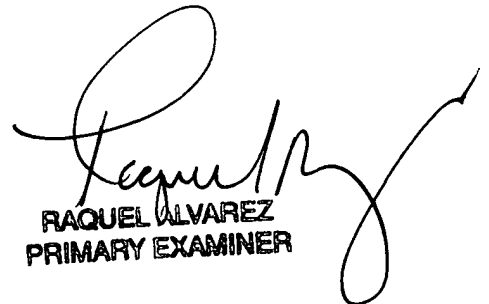
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
April 19, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER